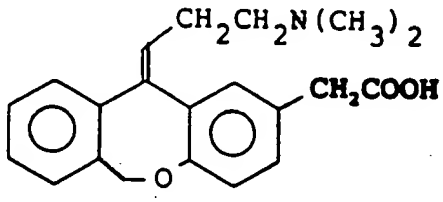
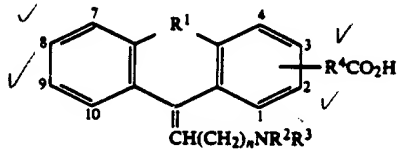
4,923,892 (newly cited).[1/] This rejection is respectfully traversed.

The present invention as recited in Claim 20 is now directed to a specific dibenz[b,e]oxepin compound in cis form, namely cis-11-(3-dimethylaminopropylidene)-6,11-dihydrodibenz[b,e]oxepin-2-acetic acid. For the Examiner's convenience, the present invention is portrayed as the following structural formula



In contrast, Lever discloses generally the compounds having the formula:



or a salt ester or amide thereof; wherein R^1 is $-CH_2-CH_2-$, $-CH_2-O-$ or $-O-CH_2-$; R^2 and R^3 are the same or different and are each hydrogen, C_{1-4} alkyl or taken together with the nitrogen comprise a nitrogen-containing heterocyclic ring having four to six ring members; R^4 is a single bond or a C_{1-7} bivalent

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1/ Both Lever patents ultimately issued from U.S. Serial No. 06/894,306 and accordingly, will not be treated independently herein.

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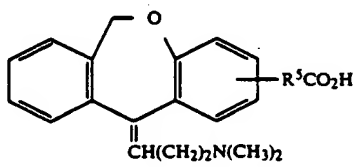
aliphatic hydrocarbon group and may be joined to the aromatic ring system at the 2, 3, 8 or 9 positions; and n is 0 to 3.

Accordingly, the Examiner will appreciate that Lever teaches a plethora of genuses comprising several different mother nucleus compounds, each of which embraces many possible combinations. In this regard, Applicants wish to point out that Lever expressly teaches that the most preferred compounds are the ones having the following structural formula:



wherein R^5 is a single bond or -CH=CH-. See Lever at column 1, lines 60-66. However, Applicants submit that the Examiner will appreciate that the above structural formula of Lever differs essentially from the presently claimed compound.

In the present compound, it is $-CH_2COOH$ that is attached to the 2 position of the benzene ring. However, in Lever, R^5COOH, which may be attached to the 2 position, is -COOH or -CH=CHCOOH. Further, of the twelve examples of the most preferred and closest prior art compounds taught by Lever (column 2, lines 20-35), none of them corresponds to the presently claimed compound. Accordingly, the Examiner will appreciate that Lever is directed at best to a genus compound embracing a vast variety of possible combinations of

substituents, forming a great number of possible compounds, and the most preferred ones of which do not correspond to the claimed compound.

It is apparent that one having ordinary skill in the art, in order to arrive at the presently claimed compound from Lever, would have to choose -- without any guidance whatsoever -- from a nearly infinite number of possible combinations. The courts have consistently ruled that when the claimed invention is not identically disclosed in a reference, but instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate. In re Arkley, 172 USPQ 524, 526, (CCPA 1972); Akzo N.V. v. International Trade Commission, 1 USPQ2d 1241, 1245-46 (Fed. Cir. 1986). Accord, In re Petering, 133 USPQ 275, 279 (CCPA 1962) wherein a generic formula which encompasses a vast number of compounds does not describe and thus fails to anticipate all compounds embraced therein merely because they are within the scope of the formula. Similarly, where a reference does not highlight or suggest the specific material of the claimed invention among a large number of materials disclosed in the reference, the reference also fails to render obvious a very specific one of those materials. In re Kollman, 201 USPQ 193, 198 (CCPA 1979).

Accordingly, Applicants submit that the pending claims are not anticipated by Lever, which does not describe

the compound recited in Claim 20 (Akzo v. ITC) and are also not obvious over Lever, which provides no guidance for arriving at the compound of Claim 20 (In re Kollman).

In any event, however, Lever also fails to teach or suggest the unexpected advantages attained by the present invention, as established below, thus overcoming any possible implication that the pending claims are obvious over Lever. As conclusive evidence of the unexpected and superior results achieved by the novel compound of the present invention over the closest compounds of record, Applicants submit herewith a Declaration under Rule 132 of Kenji Ohmori, one of the inventors of the present invention.

In the Declaration, the anti-allergic activities and the anti-asthmatic activities were compared for each of the claimed cis-11-(3-dimethylaminopropylidene)-6,11-dihydrodibenz[b,e]oxepin-2-acetic acid (Declaration Compound A) and Lever's closest prior art compounds, namely Lever compound 1 wherein R is COOH (Declaration Compound B) at column 2, lines 11-12 and Example 1 from column 7, line 33 to column 8, line 68 and Lever compound 10 wherein R is CH=CHCOOH (Declaration Compound C) at column 2, lines 29-30 and Example 5 at column 13, lines 1-68. Additionally, for the sake of completeness, the hypnotic effects of Compounds A and B were also compared.

Applicants submit that Compounds B and C are the closest compounds to the present invention that are

specifically taught by the prior art since they differ from the present invention solely by their R groups.

The results, as presented for the Examiner at Table I of the Declaration, show that Compound A exhibits vastly superior anti-allergic and anti-asthmatic activities over both of Compounds B and C. In fact, the effective dose for producing 50% anti-allergic rate for Compound A is 127% less than that for Compound B and more than 836% less than that for Compound C. As for the anti-asthmatic activity, the effective dose for producing 50% suppression rate for Compound A is 382% less than that for Compound B and more than 627% less than that for Compounds C. Accordingly, the Examiner will appreciate that at least double doses of Compounds B and C are needed simply to produce the same anti-allergic and anti-asthmatic activities as attained by Compound A. That is to say, present invention Compound A is simply more effective than the prior art.

Clearly, the results attained by the present invention are of utility and are of benefit to those of ordinary skill in the art. Moreover, Compound A shows much less hypnotic side effect as compared to Compound B. For Compound A, there was no enhancement of hypnotic effect in any of the mice tested. On the other hand, for Compound B, forty percent of the mice tested showed enhanced hypnotic effect. Additionally, it is believed to be obvious that the improvements attained by the present invention are

not suggested anywhere by Lever. That is, Applicants respectfully submit that the data presented in the Declaration clearly demonstrate that the presently claimed compound exhibits unexpected and superior effects over the compounds taught by Lever, thereby rebutting any possible presumption of obviousness. Clearly, there is nothing of record which would indicate to the contrary.

In view of the above amendments, remarks and the document submitted herein. Applicants submit that all of the claims are now in allowable condition. Accordingly, reconsideration and allowance of this application is earnestly solicited.

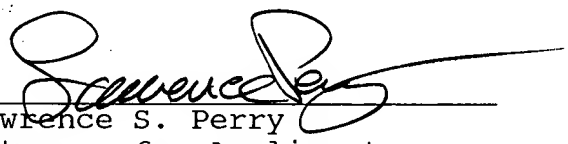
Claims 2, 18 and 20 remain in prosecution.

Applicants' undersigned attorney may be reached by telephone in our New York Office at

(212) 758-2400.

All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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